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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/750,416 | 12/31/2003 | Paul Cooper | 1671-0289 | 4647 |

7590 06/27/2006

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| EXAMINER |
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HOFFMAN, MARY C

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| ART UNIT | PAPER NUMBER |
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3733

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,416

Applicant(s)

COOPER ET AL.

Examiner

Mary Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-33 and 42-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-33 and 42-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to because of the informalities described on the attached PTO-948. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-33 and 42-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Walulik (U.S. Patent Office 5,997,537).

Walulik discloses an external bone/joint fixation device (see Figure below) comprising a frame component having a posterior portion and an anterior portion disposed transverse to the posterior portion, the frame component including a plurality of first fixation bores and a cross bar assembly attachable to the anterior portion of the frame component, the cross bar assembly including a cross bar component that is capable of being fixed at any one of a plurality of positions in relation to the anterior portion, the cross bar component having a plurality of second fixation bores, and a posterior angulation assembly attachable to the posterior portion of the frame component at any one of a plurality of positions in relation to the posterior portion: and a fixation wire extending from the posterior angulation assembly to the cross bar component. The cross bar component is capable of being rotated about a longitudinal axis of the cross bar component. The cross bar assembly further includes first and second cross bar holders each configured for attachment to the anterior portion of the frame component and for receipt of an end of the cross bar. Each cross bar holder is configured to clamp against an end of the cross bar component when the cross bar holder is mounted to the anterior portion of the frame component. The anterior portion extends above a first plane defined by the posterior portion. The posterior angulation component defines a wire retention bore configured to receive a fixator for receipt of a

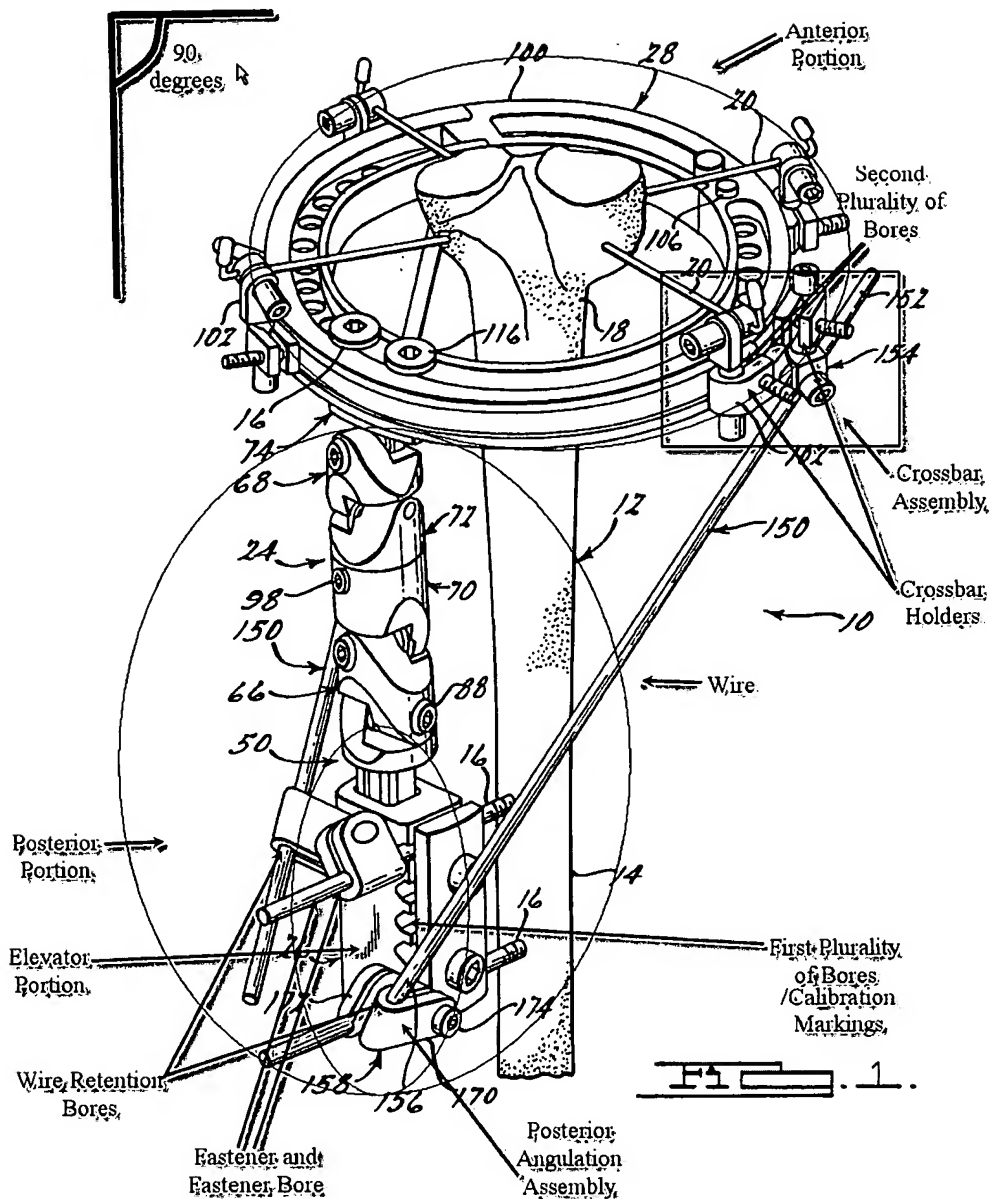
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portion of the fixation wire. The posterior angulation component further defines a fastener bore alignable with any one of the plurality of first fixation bores defined in the posterior portion of the frame component. The device further comprises a fastener extending through the fastener bore and a first of the plurality of first fixation bores defined in the posterior portion of the frame component. The device further comprising an elevator configured to extend about a bottom portion of the frame component and allowing access to a sole of the foot. The elevator is adapted to evenly distribute pressure applied thereto. The elevator is arcuate shaped. The frame component forms a continuous loop, the posterior portion defines a first part of the continuous loop, and the anterior portion defines a second part of the continuous loop. The device further comprises calibration markings disposed on the posterior portion. The frame is fabricated from at least one of a composite material, a polymer, a metal alloy and a shape memory material. The frame is fabricated from a radiolucent material (col. 8, lines 12-20).

The fixation device comprises a frame having a posterior portion defining a first plane, and an anterior portion defining a second plane which is non-coplanar in relation to the first plane; a cross bar assembly configured to be coupled to the anterior portion of the frame component, a posterior angulation assembly configured to be coupled the posterior portion of the frame component; and a fixation member extending from the posterior angulation assembly to the cross bar component. The cross bar assembly includes a cross bar component, and the cross bar component is fixable to the anterior portion of the frame component at any one of a plurality of positions. The cross bar

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component is rotatable between a first position of the plurality of positions, and a second position of the plurality of positions. The cross bar assembly further includes a first holder and a second holder, the first holder is securable to a first part of the anterior portion of the frame component, the second holder is securable to a second part of the anterior portion of the frame component, the first holder is configured to clamp a first end of the cross bar component, and the second holder is configured to clamp a second end of the cross bar component. The posterior angulation component is configured to be coupled the posterior portion of the frame component at any one of a plurality of positions along the posterior portion. The posterior portion of the frame component defines a plurality of first bores, the posterior angulation component defines a fastener bore, and the fastener bore is alignable with any one of the plurality of first bores. The device further comprises a fastener extending through the fastener bore and a first of the plurality of first fixation bores defined in the posterior portion of the frame component. The posterior angulation component further defines a wire retention bore, and the wire retention bore is configured to receive a fixator component therein. The frame component forms a continuous loop, the posterior portion of the frame component defines a first part of the continuous loop, and the anterior portion of the frame component defines a second part of the continuous loop. The first plane and the second plane define an angle between 70 to 100 degrees. The first plane and the second plane define an angle, and the angle is approximately equal to 90 degrees.



With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Walulik, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference “teach” what the

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subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Response to Arguments

Applicant's arguments with respect to claims 19-33 and 42-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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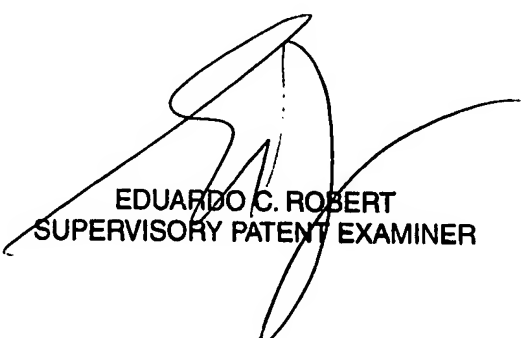
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER